REMARKS

I.   <u>Summary of the Examiner's Action</u>

A.   <u>Claim Rejections</u>

As set forth in paragraph 2 of the Office Action dated October 19, 2005 (hereinafter the "October 19 Office Action"), claims 1 – 3, 5, 6, 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,308,086 to Yoshino (hereinafter "the Yoshino patent").

As set forth in paragraph 4 of the October 19 Office Action, claims 4, 7 – 9 and 11 – 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Yoshino patent in view of United States Patent No. 6,704,582 to Le-Faucheur *et al.* (hereinafter "the Le-Faucheur patent").

II.   <u>Applicant's Response – Claim Rejections</u>

A.   <u>Rejection of Claims 1 – 3, 5, 6, 10 and 14 under 35 U.S.C. § 102(b)</u>

Applicants respectfully submit it is not seen where the Yoshino patent either describes or suggests the subject matter of the instant claims. For example, claim 1 recites "the user operating, during the providing step, selecting means of the mobile terminal so as to select part of the audio information, the mobile terminal subsequently attracting the attention of the user by playing the selected part of the audio information."

The Yoshino patent simply does not operate in this manner. This is not surprising since the Yoshino patent is directed at a different problem. In particular,

the Yoshino patent describes the problem which its disclosure purportedly solves as

follows at Column 1, lines 37 – 44:

> "In the conventional cellular phone, the melody must be
> entered, in the form of notes of a musical scale, through key
> operations. Hence, if the user does not have any knowledge about the
> musical scale, he experiences difficulty in entering a desired melody
> correctly. As a result, the user must repeatedly perform key-entry
> operations several times until a desired melody is composed."

Yoshino allegedly solves this problem by providing method and apparatus that allow

a user to enter a tune to be used as a ring tone without key operations.

Yoshino describes the apparatus as follows at Column 1, lines 45 – 67

(emphasis added):

> "The present invention has been conceived to solve such a
> problem in the prior art, and the object of the present invention is to
> provide a portable cellular phone which enables the user to enter a
> desired melody without involving key operations.
>
> To this end, a portable cellular phone according to the present
> invention comprises
>
> > **conversion means for converting a voice signal entered
> > from a microphone into a digital audio signal;**
> >
> > computation means which obtains musical scale information
> > (i.e., information in the form of notes of a musical
> > scale) by extracting from the digital audio signal
> > frequency components corresponding to notes of a
> > musical scale and which generates and outputs a
> > musical scale signal from the musical scale information;
> > and

drive means for driving an audio output device on the basis of the musical scale signal.

With the foregoing means, the user can set an original ringing tone by humming a melody and can input the desired melody in terms of notes of a musical scale without knowledge about the musical scale."

From a comparison of this description with the subject matter reproduced from claim 1 above, it is readily apparent that the disclosure of the Yoshino patent has little or nothing to do with Applicants' invention as claimed.

Whereas Applicants' invention allows a user to select a portion of a melody or some other audio information to be used as a ringing tone, the Yoshino patent is concerned with avoiding the need to enter a melody to be used as a ringing tone by allowing a user to hum the melody, the method and apparatus of Yoshino then converting the hummed melody into a form that can be used by the mobile terminal.

When viewed from this perspective, it is clear that the portions of the Yoshino patent relied upon by the Examiner as describing the portion of claim 1 reproduced above, simply do not disclose this subject matter. In case there is any lingering doubt, Applicants reproduce the relied-upon portions of the Yoshino patent (Column 3, line 55 – column 4, line 6) here:

"When the user selects a melody input function by actuation of the operation section 101 of the portable cellular phone, the operation section 101 outputs an operation signal to the control section 102. Upon receipt of the operation signal, the control section 102 outputs a

control signal to the input section 104, the computation section 105, and the output section 106.

In this state, the user hums a melody into the microphone 103. The microphone 103 outputs the user's voice as an input voice. When the control section 102 outputs a control signal including an input instruction, the input section 104 converts the input voice entered from the microphone 103 into a digital signal and outputs an audio signal.

When the control section 102 outputs a control signal including a computation instruction, through use of mathematical means the computation section 105 extracts from the audio signal entered from the input section 104 frequency components corresponding to a note of musical scale. On the basis of the thus-extracted musical scale information, a musical scale signal is produced and output."

Applicants' invention simply does not operate in this manner. Yoshino discloses a series of steps that are simply not performed by Applicants' invention as claimed. For example, the whole purpose of the method and apparatus of Yoshino is to generate a melody for use as a ringing tone that does not already exist in the mobile terminal without requiring the user of the mobile terminal to know musical scales in order to enter the melody. In Yoshino, the user enters the melody by humming the melody. In contrast, Applicants' invention allows a user to select a portion of the audio information to be used as a ringing tone. When Yoshino's method converts the melody hummed by the user, it is in no way selecting a portion of the melody; rather, it is reproducing the melody using musical scale information.

When viewed from this perspective, it is clear that the Yoshino patent does not disclose the subject matter of the claims at issue. For example, claim 1 recites

(emphasis added) *"providing the audio information to the user,* the user operating, during the providing step, selecting means of the mobile terminal so as to select part of the audio information." In Yoshino, the *user provides* the audio information (by humming), which is merely converted by the device in Yoshino. In contrast, in claim 1 audio information is *provided to the user,* the user then selects part of the audio information for use as a ringing tone. The operations described at Column 4, lines 1 - 7 relied upon by the Examiner are *not* selection operations performed with selection means by the user as the audio information is provided to the user, but *conversion* operations performed by the device of Yoshino after the user has provided the audio information to the device.

Claim 5 recites "a mobile terminal comprising: means for receiving audio information, means for allowing the user to select part of the audio information, while the receiving means receives the information . . ." Since the user provides the audio information in Yoshino, Yoshino does not disclose means for selecting part of the audio information associated with the mobile terminal. This is not surprising since the user performs any selection operation that may occur by determining what to hum. This requires no agency of the mobile terminal.

Claim 10 (as amended) recites "a mobile terminal comprising: means for receiving information, providing means for providing the audio information to the user, means operable by the user for selecting part of the audio information, while the audio information is provided to the user by the providing means . . ." Support for this amendment is found at page 3, lines 4 – 8. As discussed above with respect to

claim 1, in Yoshino, the *user provides the audio information* to the device by humming. In contrast, in claim 10, the mobile terminal provides the audio information to the user, and while the audio information is being provided to the user, the user operates means for selecting a part of the audio.

For the foregoing reasons, Applicants respectfully submit that claim 1 is patentable over the Yoshino patent. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 1. Applicants respectfully submit that independent claims 5 and 10 are patentable for reasons similar to claim 1 and for reasons attributable to their unique features as set forth above. Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 5 and 10. Claims 2 – 3, 6 and 14 are patentable as depending on allowable base claims and for reasons attributable to their unique features. Therefore Applicants respectfully request that the rejection of claims 2 – 3, 6 and 14 be withdrawn as well.

B.   Rejection of Claims 4, 7 – 9, and 11 – 13 under 35 U.S.C. § 103(a)

Applicants respectfully submit that the Le-Faucheur patent adds nothing to overcome the deficiencies of the Yoshino patent identified above.

In addition, Applicants respectfully submit that there is no motivation to combine the references, since Yoshino concerns methods and apparatus where the user provides audio information to the mobile terminal. Le-Faucheur does not operate in this manner.

Accordingly, Applicants respectfully submit that claims 4, 7 – 9 and 11 – 13 are patentable over the relied upon references, whether taken singly or in combination, as depending from allowable base claims and for reasons attributable to their unique features. Applicants therefore respectfully request that the Examiner withdraw the rejections of claims 4, 7 – 9 and 11 – 13.

C.   New Claims

Applicants have added new claims 15 – 16. New claim 16 is similar to claim 10 except that the audio information is stored in storing means of the mobile terminal prior to selection of the part of the audio information that is to function as, e.g., a ringing tone. Support for this subject matter is found in, e.g., original claim 10 and page 4, line 28 – page 5, line 6.

III.   Conclusion

Applicants submit that in light of the foregoing remarks the application is now

in condition for allowance.   Applicants therefore respectfully request that the

outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

January 19, 2006   _David M. O'Neill (35,304)_
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